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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,463	12/17/2003	Ernst-Wilhelm Schubert	71128	9591

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SCARBOROUGH, NY 10510-9227

EXAMINER
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KOHARSKI, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3763

MAIL DATE	DELIVERY MODE
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07/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/738,463	SCHUBERT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Christopher D. Koharski	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 04 May 2007.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-19 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) 1, 4 and 9 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/04/2007.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the reply filed 5/04/2007 in which claims 1, 4, 6-10 have been amended and new claims 14-19 were added. Currently claims 1-19 are pending for examination in this application.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) that was submitted on 5/04/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Specification***

The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has invoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, and acts perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means-(or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...". (Also see **MPEP 2181** (Rev. 1, Feb.2000))

Appropriate correction is required.

***Claim Objections***

Claims 1,4 and 9 are objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner has objected to the claims for the reasons set forth above in the objection to the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Prendergast (5,873,371). Prendergast discloses a patient drug recognition system.

Regarding claims 1-19, Prendergast discloses a device (6) for dispensing medical active ingredients comprising a micropump (140, 142, 144) with a computer controller (31) (col 8, ln 50-60) for evaluating data and controlling the micropumps, multiple modules with an upper and lower parts (near 132, 134, 136) with a coupling means and coupling receiving part (135, 164) capable of being coupled to an adjacent module and in series with a guiding structure (Figure 4), a code means for passing medical information and electrical signals (82, 84) (col 6, ln 25-60) (Figures 5-6b) including pins (90), a removable article (150), a fluid interface (near 128) connectable to a supply line (near 130) and base part (166, 168, 170) leading to a patient, a cartridge

(132, 134, 136) for receiving a medical active ingredient; and a delivery means for delivering (manifold near 130) the medical active ingredient from said cartridge to said fluid interface (Figures 1-8) with a solution container (128).

***Claim Rejections - 35 USC § 102***

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerns et al. (4,756,706). Kerns et al. discloses a centrally managed modular infusion pump system.

Regarding claims 1-19, Kerns et al. discloses a device (Figure 1) for dispensing medical active ingredients comprising a micropump (22) with a computer controller (14) (Figure 18) for evaluating data and controlling the micropumps, multiple modules with an upper and lower parts (22) with a coupling means and coupling receiving part (122, 124) capable of being coupled to an adjacent module and in series with a guiding structure (Figures 4a-4c), a code means for passing medical information and electrical signals (168) including pins (154), a removable article (50, 52), a fluid interface (near 54, 56) connectable to a supply line (near 52, 50) and base part (near 66) leading to a patient, a cartridge (100) for receiving a medical active ingredient; and a delivery means for delivering (manifold 40, 54, 56) the medical active ingredient from said cartridge to said fluid interface (Figures 1-18) with a solution container (28, 30, 36).

***Response to Arguments***

Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 7/19/07

  
Christopher D. Koharski  
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CATHERINE S. WILLIAMS  
PRIMARY EXAMINER